GA 3724

#9/dpw 7/21/00 Renewed Petition

TRANSMITTAL

REQUEST FOR RECONSIDERATION
UNDER 37 CFR 1.181(f)

Title:	KNIFE INDEXING APPARATUS
Inventor:	Mark Rasper
Filed:	12/28/99
Serial No.:	09/222,282
Art Unit:	3724
Examiner:	K. Tran

To the Commissioner of Patents and Trademarks
Washington D.C. 20231

Sir:

Transmitted herewith is a Request for Reconsideration under 37 CFR 1.181 (f) of the Decision on Petition of June 12, 2000..

Attached are:

4 Pages of request

1 Self addressed post card

No fees are required.

Submitted by

Russell L. Johnson

Russell. L. Johnson
Patent Agent (26,918)
P.O. Box 161
Weyauwega WI 54983

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

The Commissioner of Patents and Trademarks
Washington D.C. 20231

on JULY 3, 2000
(Date)

Russell L. Johnson
(Name of person making deposit)

Russell L. Johnson
(Signature)

July 3, 2000
(Date)

REQUEST FOR RECONSIDERATION
UNDER 37 CFR 1.181(f)

Title:	KNIFE INDEXING APPARATUS
Inventor:	Mark Rasper
Filed:	12/28/99
Serial No.:	09/222,282
Art Unit:	3724
Examiner:	K. Tran

To the Commissioner of Patents and Trademarks
Washington D.C. 20231

ATTENTION: E. ROLLINS-CROSS
Director, Patent Examining Groups 3710 and 3720

Sir;

This is a petition asking Director Rollins-Cross to reconsider the decision made June 12,2000 with regard to the petition filed by the applicant on May 25,2000 in the above described patent application.

As stated in the petition of May 25,2000 the applicant is seeking a right to respond to the office action of 05/09/00 in the above described patent application and to avoid if possible the need for appeal and remand.

The applicant submits that his response to the office action of 02/10/00 was a bonafide effort to resolve the question of availability of Bailey (U.S. 5,761,976) as a 35 U.S.C. 103(a) reference in rejecting applicants claim 1. On that basis, the examiner is not required to make the next office action final. To the extent that the examiner's decision to make the office action of 05/09/2000 final was discretionary it is submitted that he arbitrarily chose to do so.

In the office action of 02/10/00 (first office action) Bailey was not cited as a 35 U.S.C 102 reference and the examiner noted that Bailey differed materially from the claimed invention in that Bailey was absent a worm and worm gear. The worm and worm gear are central and critical to the applicants invention. Therefore Bailey would not qualify as an anticipatory reference. No mention whatsoever was made in the action of 02/10/00 to 35 U.S.C 102.

In the office action of 05/09/2000 (second office action) the subject of 35 U.S.C 102 is raised for the first time by the examiner. He raises the matter as a hypothetical argument that "However, had Bailey been cited as a rejection under 35 U.S.C 102 it would have qualified as a 35 U.S.C 102(e) which is reliant on the filing date. Therefore, Bailey as a 35 U.S.C. 103(a) reference is deemed proper.". It is submitted that matter presented for the first time is new matter, and arguments made for the first time are new arguments. It is further submitted that to deny an applicant the right to respond to a novel argument made for the first time in an office action that is made final is inherently unfair.

In the office action of 05/09/00 examiner Tran does not state that Bailey is a proper 35 U.S.C 102 anticipatory reference nor make a 35 U.S.C. 102 rejection. Had he done so the applicant could possibly have traversed that rejection or sworn behind the filing date of the reference. To deny him the right to do so is inherently unfair.

In the office action of 05/09/00 and specifically in the quotation cited in the previous paragraph, examiner Tran's determination that "Bailey as a 35 U.S.C 103(a) reference is deemed proper.", the examiner quotes no authority, cites no case law, and relies on no rule or law in giving to Bailey the standing as a 35 U.S.C. 103(a) reference as of its filing date and based on a hypothetical "had Bailey been cited as a rejection under 35 U.S.C. 102...". If there is a 35 U.S.C 102 exception to the "at the time the invention was made" clause in 35 U.S.C. 103 the examiner has not provided the applicant with citations that would enable him to respond to the examiner's interpretations of those citations. That is inherently unfair. The examiners finding that "Therefore, Bailey as a 35 U.S.C. 103 (a) reference is deemed proper.", is arbitrary and is without foundation in fact or law.

The applicant respectfully submits that; examiner Tran's finding based on a hypothetical possibility that a non 35 U.S.C. 102 reference could have been used as a 35 U.S.C. 102 reference, and therefore the reference is available as a 35 U.S.C. 103 reference, is clear error. Were it proper, it would make it necessary to amend 35 U.S.C.103 to delete the "at the time the invention was made" clause. The effect of sustaining examiner Tran's rejection on appeal would be to render all 35 U.S.C 103 references available as of their filing date because they could have been cited as 35 U.S.C.102 references.

The applicant respectfully submits that examiner Tran's finding that Bailey as a 35 U.S.C. 103 (a) reference is proper based on a hypothetical 35 U.S.C. 102 situation is clear error and would be reversed on appeal.

Therefore, the applicant petitions Director Rollins-Cross to reconsider the decision of June 12, 2000 and now find that examiner Tran's final rejection made in the office action of 05/09/00 is premature and that the action be vacated. The applicant asks that he be afforded a full and fair opportunity to respond to the examiner's findings, and decisions related to the applicability of 35 U.S.C. 102 dates of availability to 35 U.S.C. 103 references.

Reversal of the Decision on Petition of June 12, 2000 is respectfully requested.

Respectfully submitted by

Russell L. Johnson 07/08/00

Russell L. Johnson
Patent Agent (26,918)
P.O.Box 161
Weyauwega WI 54983
414/867-34820

REQUEST FOR RECONSIDERATION
UNDER 37 CFR 1.111

Title:	KNIFE INDEXING APPARATUS
Inventor:	Mark Rasper
Filed:	12/28/99
Serial No.:	09/222,282
Art Unit:	3724
Examiner:	K. Tran

To the Commissioner of Patents and Trademarks
Washington D.C. 20231

Sir;

This is a request under 37 CFR 1.111 for examiner Tran to reconsider his decision to make the office action of 05/09/00 final.

The applicant submits that in the office action of 05/09/00:

1) the examiner raises for the first time matters related to 35 USC 102,

2) the examiner argues for the first time that because a reference would be available as of its filing date in making a 35 U.S.C. 102 rejection it is available as of its filing date for the purpose of making a 35 U.S.C.103(a) rejection.

3) the examiner provides no citations of rule or law or procedure or precedence in support of his determination that Bailey is available as a 35 U.S.C. 103 reference as of its filing date and thereby denies the applicant a right to challenge the legal foundations of the examiners deeming

Bailey to be available as a 35 U.S.C. 103 (a) reference as of its filing date.

4) the examiner in making the action final denies the applicant the right to traverse the 35 U.S.C. 102 portion of the examiner's 35 U.S.C. 103 (a) rejection of claim 1.

5) the examiner in making the action final denies the applicant the right to respond to the examiner's arguments in support of availability of Bailey as a 35 U.S.C. 103 (a) reference as of the filing date of Bailey.

The examiner rejects claim 1 under 35 U.S.C. 103 (a) as being unpatentable over Bailey in view of Cavalli as set forth in the previous action.

In the previous action the examiner states "Bailey discloses the invention substantially as claimed except for the use of worm gears and shaft." The worm shaft, worm, and worm gear are central and critical to the invention of claim 1. Bailey does not show teach or claim a worm shaft, a worm, or a worm gear. Therefore Bailey is not an anticipatory reference under 35 U.S.C. 102.

Further. Cavelli does not show teach or claim a worm shaft, a worm, or a worm gear.

The applicant submits the prior art references relied upon by the examiner do not show, teach or claim a worm shaft, a worm, and a worm gear. Therefore, they do not provide a motive to look in the direction of a worm shaft, worm, and a worm gear as an indexing means.

Further, the threaded tool advancing means of Cavelli advances a rotating tool towards a work piece. The worm and worm gear of this invention indexes a non-rotating tool which is advanced by associated means into a workpiece. The means for rotation and advancement of the tool of Cavelli is a hand wheel and threaded

shaft which is different from the worm and worm gear means for rotation and indexing of the tool of this invention. The mode of operation of the threaded tool advancement of Cavelli is different from the mode of operation of the worm and worm gear tool indexing means of this invention. The end achieved by the threaded tool advancement means of Cavelli is different from the end achieved by the worm and worm gear tool indexing means of this invention. Cavelli is from an art area that is remote from the core cutting art.

The applicant respectfully submits that the examiner's argument "in view of Cavelli, it would have been obvious to one having skill in the art to provide Bailey's device with a worm gear to rotate a cutting tool since a worm gear mechanism is well-known in the art" is a hindsight construction of the examiner which would require one skilled in the art to find the means of rotation, the mode of operation and the end achieved by the worm and worm gear of this invention in Cavelli where neither a worm or worm gear is present and indexing is not a function of Cavelli. One skilled in the art would then need to be motivated to transfer this metamorphosis to the core cutting art to apply it to Bailey. Cavelli taken as a whole does not meet the language of claim 1 nor does Cavelli provide motivation for one skilled in the art to look in the direction of worm and worm gear as an indexing means nor to look in the direction of the core cutting art to apply as an indexing means the worm and worm gear which is at the heart of and is a part of the essence of the invention of claim 1.

Further the applicant respectfully submits that Bailey was not in fact a part of the prior art at the time the instant invention was made and therefore the prior art relied on by the examiner taken as a whole can not render the applicants claim 1 obvious under 35 U.S.C. 103 (a). The applicant now asks that the examiner so find and that he find applicant's claim 1 to be allowable under 35 U.S.C. 103 (a).

With regard to the examiner's finding that Bailey is available as

a 35 U.S.C. 103 (a) prior art reference as of its filing date, the applicant respectfully submits that the finding is clear error and that at the very least the applicant's right to respond to a legal foundation for the finding should be honored and the examiner at the very least find the making final of the office action of 05/09/00 was premature and that the applicant be afforded a full and fair opportunity to respond to and to traverse the examiner's findings as to the effective date of Bailey and to swear behind the effective date of Bailey if need be.

Therefore, allowance of claim 1 is now respectfully requested and that failing, a finding that the making final of the the action of 05/09/00 is premature is respectfully requested.

Submitted by

Russell L. Johnson 07/03/00

Russell L. Johnson
Patent Agent
P.O. Box 161
Weyauwega WI 54983
920/867-3482